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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,422	03/31/2004	Ratinder Paul Singh Ahuja	6897P006	8851
8791 7590 02/13/2007 BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 90025-1030			EXAMINER SALOMON, PHENUEL S	
			ART UNIT 2109	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			02/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/816,422

Applicant(s)

AHUJA ET AL.

Examiner

Phenuel S. Salomon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to the original filing of March 31, 2004. Claims 1-21 are pending and have been considered below.

#### ***Objections***

2. The disclosure is objected to because of the following informalities: the examiner notes the use of acronyms: such as SYN and others, in the specification without including a description in plain text, as required. Appropriate correction is required.

3. The disclosure is objected to because of the following informalities: the examiner notes some mistakes: such as "...data stream by the ressembler 36." (page 11, para. [0035]), please check the disclosure carefully for other type of similar mistakes.

Appropriate correction is required.

4. Claim 6 is objected to because of the following informality: the examiner notes a typographical mistake: "...a capture rule editor a to enable..." (line 1). Appropriate correction is required.

#### ***Drawings***

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the

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description: "setup view 708", "search engine 64 and the notification module 66" (Fig. 8).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5, 7-10, 12-15, and 17-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a system or method for authoring and editing using a capture rule editor device, does not reasonably provide enablement for using a single definition for authoring and editing data without a database. The method in this claim consists of a single step: "using a search editor for data authoring and editing", and thus is interpreted as a single means/single step claim under MPEP 2164.08(a).

"A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth

rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor."

7. Examiner's Note. The Applicant appears to be attempting to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph in Claims 12 and 14-16 by using "means-plus-function" language.

However, the Examiner notes that the only "means" for performing these cited functions in the specification appears to be computer program modules. While the claim passes the first test of the three-prong test used to determine invocation of paragraph 6, since no other specific structural limitations are disclosed in the specification, the claim does not meet the other tests of the three-prong test. Therefore, 35 U.S.C. 112 6<sup>th</sup> paragraph has not been invoked when considering the claims below.

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 (e) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 7, 12 and 17- are rejected under 35 U.S.C. 102(e) as being anticipated by Dunlavey (US 6,937,257 B1)

Claims 1, 7, 12 & 17: Dunlavey discloses a graphical user interface (GUI), a system and a method for a capture system, the GUI comprising:

a search editor to enable a user to author and edit (modify) a search that mines objects captured by the capture system (col. 4, lines 32-35).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2-5, 8-10, 13-15, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlavey (US 6,937,257 B1) in view of Henderson (US 2004/0181513 A1).

Claim 2: Dunlavey discloses a GUI as in claims 1 above, but does not explicitly disclose the search editor is configured to enable the user to author the search to include both indexed and non-indexed search criteria. Henderson discloses a "query application to obtain any sort of information from a relational database..." (page 2, par. [0030]).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include that feature in Dunlavey. One would have been motivated to do so in order to give the user convenience of complex search language.

Claims 3, 8, 13 & 18: Dunlavey discloses a GUI, a system and method as in claims 1, 7, 12 & 17 above, but does not explicitly disclose the search editor enables the user to specify one or more of a plurality of search criteria, the search criteria including a content type, a protocol, keywords, and word patterns. Henderson discloses a "gui that may contain values and processes associated with the contents..." (page 4, par. [0044]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include content search criteria in Dunlavey. One would have been motivated to do so in order to facilitate the user with the search criteria.

Claims 4, 9, 14 & 19: Dunlavey discloses a GUI, a system and method as in claims 3, 8, 13 & 18 above, but does not explicitly disclose the search criteria further include a source address, a destination address, a size range, and a temporal range. Henderson discloses a "query page that may include a plurality of fields for the user to enter search parameter..." (page 6, par. [0054] and fig 14). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include that feature in Dunlavey. One would have been motivated to do so in order to give the user a real flexible way to perform a complex search.

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Claims 5, 10, 15 & 20: Dunlavey discloses a GUI, a system and method as in claims 1, 7, 12 & 17 above, but does not explicitly disclose the search editor enables the user to specify one or more of a plurality of search criteria, the search criteria including an email source, an email destination, and email carbon copy, an email subject, and message keywords. Henderson discloses a "TRNText may be provided to look up message text information..." (page 4, par. [0042]). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a plurality of search criteria in Dunlavey. One would have been motivated to do so in order to minimize search times.

11. Claims 6, 11, 16 & 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlavey (US 6,937,257 B1) in view of Knight (US 6,515,681 B1).

Claims 6, 11, 16 & 21: Dunlavey discloses a GUI, a system and method as in claims 1, 7, 12, & 17 above, but does not explicitly disclose a capture rule editor to enable a user to author and edit a capture rule used by the capture system to intercept objects transmitted over a network. Knight discloses an "online data system that can be captured..." (col 25, lines 13-26). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include that feature in Dunlavey. One would have been motivated to do so in order to keep intruders and



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unauthorized personnel from accessing valuable information, therefore; a secure network.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Kirk et al. (US 5,768,578) discloses user interface for information retrieval system.

b. Goldberg et al. (US 2005/0004911 A1) discloses graphical condition builder for facilitating database queries.

c. Hara et al. (US 2004/0111678 A1) discloses method for retrieving document.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phenuel S. Salomon whose telephone number is (571) 270-1699. The examiner can normally be reached on Mon-Fri 7:00 A.M. to 4:00 P.M.(Alternate Friday Off) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Myhre can be reached on (571) 270-1065. The fax phone number for the organization where this application or proceeding is assigned is 571-273-3800.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PSS  
2/7/2007



James W. Myrhe  
Supervisory Primary Examiner